UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,135	05/17/2005	Takahiro Tsutsui	03597.000900.	3571

5514 7590 03/06/2009

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER	
HIGGINS, GERARD T	

ART UNIT	PAPER NUMBER
1794	

MAIL DATE	DELIVERY MODE
03/06/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 02/25/2009 will not be entered because it raises issues of new matter and new issues that require further search and consideration.

With regard to the issues of new matter, it is noted that applicants' amendment changes the upper limit for the total proportion of "said thiodipropionic acid or said salt thereof and said tocopherol or said derivative thereof" from "less than 10 wt. %" to "5 wt. %." Applicants draw support for this amendment from throughout the specification as filed, and particularly page 22, lines 17-20.

The Examiner does not find support for this amendment throughout the specification as filed or at page 22, lines 17-20. It has been held that when an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description ***requires*** that limitation" (emphasis added). *Hyatt v. Boone*, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998).

While the disclosure at page 22, lines 17-20 does disclose that "tocopherol and thiodipropionic acid were added in a total solid proportion of 5 %," it is noted by the Examiner that the disclosure at page 20, line 28 to page 22, line 20 discloses a specific ink-receiving layer comprised of a specific inorganic pigment (i.e. aluminum hydrate dispersion B), specific water-soluble and/or water-dispersible resins, thiodipropionic acid

only, and tocopherol only. This disclosure does not enable applicants to broadly claim this 5 wt. % limitation for all inorganic pigments, all water-soluble and/or water-dispersible resins, all salts of thiodipropionic acid, and all derivatives of tocopherol as is claimed.

With regard to applicants' reference to *In re Wertheim*, it is noted that while the Examiner agrees that the court ruled that a specification that described a range of 25 percent to 60 percent and described specific examples of 36 percent to 60 percent was sufficient to provide written description for a claim to "between 35 % and 60 %," the court also made a clear disclaimer to their ruling. They stated that "[w]e wish to make it clear that we are not creating a rule applicable to all description requirement cases involving ranges." They ruled in this specific case that the PTO did not meet their burden of providing a "sufficient reason to doubt that the broader described range also describes the somewhat narrower claimed range;" furthermore, in the present instance, the Examiner does not see the facts as being comparable because applicants are looking for support for 10 %, while their disclosure only is supported for 1 %, 5 % (for a single specific embodiment), and 20 %. The court in *Wertheim* found that the single embodiment for 36 % in combination with the broad range provided support for the endpoint of 35 %. As per the facts in this case, the Examiner does not find that 1 %, 5 % (for a single specific embodiment), or 20 % provide adequate written description for the broadly claimed 10 %.

With regard to the new issues that require further search and consideration, the Examiner notes that applicants' claims were drawn to a broader range, and now they

are seeking to further limit this broad range. This narrower range will require further search and consideration.

It is also noted that even if this amendment were entered, the Examiner would continue to reject claims 1 and 3-6 using the same prior art as set forth in the previous Office action.

Applicants appear to be arguing that Malhotra et al. is not an operable reference.

With regard to the reference being "non-enabling," as set forth in MPEP 2121, "when a reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability." See *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980) and also MPEP § 716.07. Also it has been held that a reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention." Please see *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed.Cir. 1985). The Examiner holds that the disclosure that the materials may be present "in any desired or effective amount" reads on or renders obvious applicants' claimed limitation of 1 to less than 10 % or 1 to 5 %.

Applicants also argue that "one of ordinary skill in the art would necessarily have to conduct ***innumerable*** experiments to modify the percentage" and that "[t]he

possibility of ***unending*** experimentation does not evidence obviousness" (emphasis added).

The Examiner respectfully disagrees with applicants' premise. One of ordinary skill would learn from the disclosure of Malhotra et al. that the amount of thiodipropionic acid and tocopherol can be present in any amount in the layer. Working from this teaching, one of ordinary skill in the art would know to vary the amount of tocopherol and thiodipropionic acid to any amount, including those claimed, in order to arrive at a recording medium that had the proper amount of lightfastness and image sharpness. Given the preferred ranges of Malhotra et al., one of ordinary skill would know to start with those ranges in order to determine if it provided the optimal amount of lightfastness and image sharpness; however, given the disclosure that they may be present "in any desired or effective amount," it would have been clear to one having ordinary skill in the art to vary the percentages from the preferred ranges to determine if there was an benefit to the lightfastness and image sharpness. This would include applicants' claimed range, and this type of experimentation would not be innumerable or unending as suggested by applicants.

Lastly, it is important to note that applicants have provided no evidence of unexpected results over the disclosure of Malhotra et al. resulting from their range.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is

(571)270-3467. The examiner can normally be reached on M-F 9:30am-7pm est. (1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gerard T Higgins
Examiner
Art Unit 1794

/Gerard T Higgins/
Examiner, Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794